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FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES CA 90045

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OFFICE OF PETITIONS

In re Application of :
Isaza et al. :
Application No. 09/811,104 : DECISION REFUSING STATUS
Filed: 16 March, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. PURIT 54796 :

This is in response to the petition filed under 37 CFR 1.47(a) on 3 May, 2001, and the petition filed under 37 CFR 1.324 on 16 March, 2001. The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

The petition under 37 CFR 1.324 is **DISMISSED AS MOOT**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed as a reissue application on 16 March, 2001, without an oath or declaration. Accordingly, on 3 May, 2001, petitioners filed a reissue declaration naming Fernando J. Isaza, Stanley Y. Wong, and Peter Doyle as joint inventors and signed by joint inventors Isaza and Doyle on behalf of themselves and joint inventor Wong.

Petition Under 37 CFR 1.47(a)

Petitioners state that joint inventor Wong could not be found. A

copy of the application, state petitioners, was forwarded to Wong's last known address but was returned as undeliverable. Petitioners further state that they contacted Wong's former employer in an attempt to obtain a more recent address for Wong, but that no other address could be obtained.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1), (2), and (5). In regards to items (1), petitioner has not submitted sufficient evidence to prove that diligent efforts have been made to locate the non-signing inventor.

Petitioners state that a copy of the application sent to the last known address of the non-signing inventor was returned as undeliverable, and that petitioners' counsel contacted the non-signing inventor's former employer, but was unable to obtain a more recent address. A brief Internet search, however, suggests that joint inventor Wong may now be living in Rancho Santa Margarita, CA.

Petitioners should verify the last known address of the non-signing inventor, and, if a current address is discovered, send or give a copy of the application (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor at the last known address. If the inventor refuses to sign in writing, a copy of that written refusal must be submitted with any renewed petition. If the inventor refuses orally, a person to whom that refusal was made must provide details of the refusal in an affidavit or declaration of facts. If the application is returned as undeliverable, a copy of the envelope showing the application papers were returned as undeliverable should be submitted with any renewed petition.

Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. through e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

With regards to item (2), the declaration is defective because (a) the declaration does not specify the mailing address, and the residence, if the inventor lives at a different location than where the inventor receives mail, for each inventor, and (b) the reissue declaration does not state that all errors being corrected in the reissue application up to the time of filing of the oath or declaration arose without any deceptive intention on the part of the applicant.¹

In regards to item (5), petitioners should verify the validity of the last known address as described under item (1), above.

Additionally, the consent of assignee as required by 37 CFR 1.172(a) and 37 CFR 3.73(b) is defective in that the person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee.² The person signing the statement is identified as an assistant secretary of the assignee. The statement must be signed by an officer of the corporation (president, vice president, secretary, or treasurer), or, if the statement is not signed by an officer of the assignee corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.³

¹37 CFR 1.175(a)(2).

²See MPEP 324.

³See MPEP 409.03(b).

Petition Under 37 CFR 1.324

With respect to the petition under 37 CFR 1.324, the reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship.⁴ A request under 37 CFR 1.48 or a petition under 37 CFR 1.175 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.175 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. § 251.

The petition fee of \$130.00 submitted with the petition under 37 CFR 1.324 will be credited to counsel's deposit account, No. 06-2425.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

⁴See A.F. Stoddard & Co. v. Dann, 564 F.2d 556, 567, 195 USPQ 97, 106 (D.C. Cir. 1977).

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D. Wood", written in black ink.

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy